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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,574	04/07/2004	Norman C. Fawley	59910P004D	8566

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER

BOCHNA, DAVID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/820,574

Applicant(s)

FAWLEY, NORMAN C.

Examiner

David E. Bochna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed on 4/7/04 and 3/25/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. All of the foreign references and non-patent literature documents with lines through them are not present in the application. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by van der Linden et al.

In regard to claims 1, 10 and 12, van der Linden et al. discloses an apparatus comprising:

a first and second pipe segment (see fig. 3) each having a core and a composite 5 (5 can be made from asbestos cement (see col. 8, line 9), which is a composite material) reinforcing circumferentially surrounding the core 4, each pipe segment further having a first end with a cutback region in which the core is exposed, the first and second pipe segments joined at their

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respective first ends, and a joint tape 1 overlaying the cutback region and adhering to the first and second pipe segments.

In regard to claim 2, the core 4 is metal.

In regard to claims 3 and 13, a primer 3 coated on the cut-back portion of the first ends to bind the joint tape to the first ends.

In regard to claim 4, a resin saturated reinforcement tape 1 (1 is made from a resin, if the tape is made from a resin material, it must be saturated with resin material) extending circumferentially around the cutback region.

In regard to claim 9, at least one line of hot melt 2 running in a warp direction.

In regard to claim 11, a means 3 for binding the joint tape means to the first ends.

7. Claims 1, 4-7 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Galloway.

In regard to claims 1 and 10 Galloway discloses an apparatus comprising:

a first 2 and second 2' pipe segment each having a core and a composite 4, 4' reinforcing circumferentially surrounding the core, each pipe segment further having a first end 2, 2' with a cutback region in which the core is exposed, the first and second pipe segments joined at their respective first ends, and a joint tape 12, 13 overlaying the cutback region and adhering to the first and second pipe segments.

In regard to claim 4, a resin saturated reinforcement 14 extending circumferentially around the cutback region.

In regard to claim 5, the reinforcement tape 14 is comprised of woven fabric.

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In regard to claim 6, the resin tape is a warp dominated fiber material (see col. 3, lines 45-52).

In regard to claim 7, a veil 15 extending circumferentially around the reinforcement tape 14.

In regard to claim 11, means 14 for binding the joint tape 12, 13 to the first ends.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galloway in view of Ewing et al. Galloway discloses a nylon resin reinforcement tape as described above, but not a glass fiber resin reinforcement tape. Ewing et al. (col. 9, lines 22-43) teaches that glass and nylon are equivalents well known in the art used for providing strength. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute the nylon fibers of Galloway with glass fibers.

***Response to Arguments***

4. Applicant's arguments filed 10/18/04 have been fully considered but they are not persuasive. Applicant argues that van der Linden et al. fails to disclose a joint tape means circumferentially overlaying the first ends "to provide hoop strength". In response to applicant's argument that the joint tape means 1 of van der Linden et al. does not provide hoop strength, a recitation of the intended use of the claimed invention must result in a structural difference

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between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case the joint tape 1 of van der Linden et al. is circumferentially attached to the perimeters of the first and second pipe segments. Therefore the joint tape is capable of providing some amount of hoop strength support to the joint, as the tape is made out of a material that is capable of withstanding some strain value. Van der Linden does not have to teach that the tape 1 provides hoop strength or reinforcement to the joint, because the tape, when circumferentially attached to the connection, inherently provides some hoop support. Therefore, van der Linden et al. anticipates independent claims 1-3 and 9-13.

In regard to Galloway, the Applicant argues that Galloway discloses a “flexible hose” and not a “pipe”, as recited in the present invention. As explained above, Galloway discloses a pipe core 2, 2’ with a composite reinforcement 4, 4’. The term “pipe” does not require a rigid tubular wall. See Merriam Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition. Webster’s defines “pipe” is as “a long tube or hollow body for conducting liquid or gas”. Therefore, the pipe 2,2’ of Galloway anticipates the claimed invention as explained in further detail above.

In regard to claim 6, Applicant argues that the tape of Galloway is not a “warp-dominated” fiber material. Col. 3, lines 45-53 of Galloway discloses that the cord fabric 15 is made up of warp yarns that extend alternately in right and left hand spirals in the successive layers, which correspond to the direction of greatest tensile strength of the fabric. Because claim

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6 is unclear as to how many “warps” are needed to make a “warp-dominated fiber material” and the prior art discloses that warps extend in the direction of greatest tensile strength, it is assumed by the Examiner that the fabric of Galloway is “warp dominated”, as the warps provide the greatest strength of the fabric.

In regard to claim 8, Ewing et al. teaches that nylon and glass fiber are well known equivalents in the art and substitutable for the reasons described above. Also, Inasmuch as the references disclose these elements as art recognized equivalents, it would have been obvious to one of ordinary skill in the exercise art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982).

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David E. Bochna  
Primary Examiner  
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